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10/702,094	11/05/2003	Robert P. Madill JR.	5053-64100	6815

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EXAMINER	
WINTER, JOHN M	

ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/702,094	MADILL ET AL.	
	Examiner	Art Unit	
	JOHN M. WINTER	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *66,67, 69- 83,101, 134 and 159-167* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *66,67, 69- 83,101, 134 and 159-167* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on May 27, 2008 is hereby acknowledged, Claims 66,67, 69- 83,101, 134 and 159-167 remain pending .

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 66 and 134 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

Claim 66 discloses a mere nominal recitation of technology and fails to transform the underlying subject matter to a different state, therefore the claimed method is non-statutory and rejected under 35 U.S.C. 101 (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)).

Claim 134 contains similar limitations and is rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 66,67, 69-83,101, 134 and 159-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres et al., (US Patent Application No 2005/0043961) and further in view of Pendleton, Jr. (US Patent 6,253,186), and further in view of Suresh et al. (US Patent 7,263,492)

As per claim 66,

Torres et al. ('961) discloses a method, comprising:

providing at least two fraud potential indicators for a request (paragraph 21)

wherein a first fraud potential indicator for the request is assessed using a first fraud potential detection technique and a second fraud potential indicator for the request is assessed using a second fraud potential detection technique, wherein the first fraud potential detection technique is different from the second fraud potential detection technique; (paragraph 23)

displaying a score or rank for at least the first and second fraud potential indicators in a graphical user interface.(Figure 7)

determining a weighted, combined fraud potential indicator for the request (Paragraphs 22 and 43)

Torres et al. ('961) does not explicitly disclose wherein the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill combines at least the first fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill assessed using the first fraud technique and the second fraud potential indicator assessed for the request corresponding to the particular accident, financial transaction, or medical bill using the second fraud technique, wherein, in combining the first fraud potential indicator and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request corresponding to the particular accident, financial transaction, or medical bill for review if the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted, combined fraud potential indicator exceeding the threshold value.. Pendleton, Jr. ('186) discloses wherein the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill combines at least the first fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill assessed using the first fraud technique and the second fraud potential indicator assessed for the request corresponding to the particular accident, financial transaction, or medical bill using the second fraud technique, wherein, in combining the first fraud potential indicator

and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request corresponding to the particular accident, financial transaction, or medical bill for review if the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted, combined fraud potential indicator exceeding the threshold value. (column 7, lines 35-59) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Torres et al. ('961)'s method with Pendleton, Jr. ('186)'s teaching in order to determine the rate of increase of fraudulent claims; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Torres et al. ('961) does not explicitly disclose a request to a financial institution relating to a particular accident, a particular financial transaction, or a particular medical bill. Suresh et al. ('492)discloses a request to a financial institution relating to a particular accident, a particular financial transaction, or a particular medical bill. (Discussion of claim data, beginning on column 6, line 64) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Torres et al. ('961)'s method with Suresh et al. ('492)'s teaching in order to only process claims relevant to a specific dispute.

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the

essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 76, 80, 134 and 162 are not patentably distinct from claim 66 and are rejected for at least the same reasons.

As per claim 67,

Torres et al. ('961) discloses the method of claim 66,

wherein clicking on at least one fraud potential indicator for the at least one request will display information about the at least one request. (paragraph 47, figure 7)

As per claim 69,

Torres et al. ('961) discloses the method of claim 66, further comprising

wherein at least one request is an insurance claim, and at least one insurance claim is organized into lists according to at least two of referred claims, assigned claims, or rejected claims, and wherein selecting a graphical component respective to at least one of a referred claims, desired claims, or rejected claims brings up a list of claims in the corresponding list.(Figure 9)

As per claim 70,

Torres et al. ('961) discloses the method of claim 66, further comprising

further comprising changing a criteria about which claims to display by selecting a filter graphical component. (Figure 8)

As per claim 71,

Torres et al. ('961) discloses the method of claim 66, further comprising

assigning at least one request by selecting an desired graphical component. (Figure 7)

As per claim 72,

Torres et al. ('961) discloses the method of claim 66, further comprising

rejecting at least one request by selecting a reject graphical component.(Figure 1)

As per claim 73,

Torres et al. ('961) discloses the method of claim 66,

wherein at least one gaud potential detection technique comprises predictive modeling.(Paragraph 21)

Claims 77 and 81 are in parallel with claim 73 and are rejected for at least the same reasons.

As per claim 74,

Torres et al. ('961) discloses the method of claim 66,

Official Notice is taken that "at least one fraud potential detection technique comprises at least one identity search of insurance claim data" is common and well known in prior art in reference to fraud detection protocols. It would have been obvious to one having ordinary skill

in the art at the time the invention was made to use an identity search in order to expose any aliases that the claim filer may have used in the past.

Claims 78 and 82 are in parallel with claim 74 and are rejected for at least the same reasons.

As per claim 75,

Torres et al. ('961) discloses the method of claim 66,

wherein at least one fraud potential detection technique comprises assessing request data using at least one business rule(Paragraph 21).

Claims 79 and 83 are in parallel with claim 75 and are rejected for at least the same reasons.

As per claim 159,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a predictive modeling engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the

essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 160,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a identity search engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 161,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a business rule engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match

used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 163 is parallel with claim 161 and is rejected for at least the same reasons.

Claims 164-167 are not patentably distinct from the above rejected claims and are rejected for at least the same reasons.

Response to Arguments

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685